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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,825	05/21/2004	Nadia Gardel	119740	8388

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OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA, VA 22320-4850

EXAMINER	
FRAZIER, BARBARA S	
ART UNIT	PAPER NUMBER
1611	
MAIL DATE	DELIVERY MODE
10/01/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/849,825	GARDEL ET AL.	
	Examiner	Art Unit	
	BARBARA FRAZIER	1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-104* is/are pending in the application.

4a) Of the above claim(s) *31-39,43-47,86-94,98-102 and 104* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30,40-42,48-85,95-97 and 103* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/18/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Claims 1-109 are pending in this application.

2. Claims 31-39, 43-47, 86-94, 98-102, and 104 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected subject matter, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/18/07.

3. Claims 1-30, 40-42, 48-85, 95-97, and 103 are examined.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-30, 40-42, 48-85, 95-97, and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanna et al (US Patent 5,843,417) in view of Bara (US Patent 5,919,468).

The claimed invention is drawn to a fluid cosmetic composition in the form of a water-in-oil emulsion comprising a liquid fatty phase, an aqueous phase, a dimethicone copolyol and solid particles of polymethyl methacrylate, the liquid fatty phase comprising isododecane and the composition being free of cyclotetrasiloxane (see claim 1).

Hanna et al teach a water-in-oil (W/O) emulsion, wherein the oil is preferably a C10-C14 saturated, linear, or branched hydrocarbon such as isododecane (col. 1, lines

49-54). The emulsion contains one or more surfactants such as dimethicone copolyol, lauryl methicone copolyol, and cetyl dimethicone copolyol (col. 5, lines 3-5). The W/O emulsion preferably contains a water-soluble and/or water-dispersable polymer (col. 2, lines 4-6). The compositions are cosmetic products, which may be used on the skin, such as a liquid foundation, concealer, or blush (col. 1, lines 34-35). The composition may also contain other oils commonly used in cosmetic emulsions such as silicone oils, including volatile silicone oils such as linear and cyclic silicone oils (col. 3, lines 33-35) and does not contain cyclotetrasiloxane.

Hanna et al do not specifically teach the presence of polymethyl methacrylate particles in the composition.

Bara teaches a composition which may be a water/oil emulsion (col. 3, lines 58-59). The compositions may contain fillers, such as poly(methyl methacrylate) in order to modify the texture of the formulation (col. 3, line 66 – col. 4, line 2). The compositions are useful in a care or make-up formulation (col. 3, lines 50-54).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use poly(methyl methacrylate) as taught by Bara with the emulsion taught by Hanna et al; thus arriving at the claimed invention. One skilled in the art would have been motivated to do so because the addition of a filler such as poly(methyl methacrylate) provides the benefits of modifying the texture of the formulation, as taught by Bara. One would reasonably expect success from the addition of poly(methyl methacrylate) as taught by Bara to the emulsion taught by Hanna et al

because both references are drawn to W/O emulsions useful in cosmetic compositions for making up the skin.

Regarding the density ranges and differing densities of two polymethyl methacrylates (claims 2-12 and 50-60), it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine the densities and percentages at which the particles of polymethyl methacrylate are most effective. The result-effective adjustment in conventional working parameters (e.g., determining the appropriate particle densities, relative densities and weight percentages within the composition) is deemed merely a matter of judicious selection and routine optimization, which is well within the purview of the ordinary artisan.

Regarding the amount of polymethyl methacrylate (claims 13-15 and 61-63), Hanna et al teach that useful amounts of fillers include 0.1-10 wt.% (col. 6, lines 39-43), and Bara teaches that fillers may be present in quantities of 0-40% by weight (col. 4, lines 1-4). These amounts overlap those of the claimed invention, and one skilled in the art would have been motivated to select optimal amounts of polymethyl methacrylate from within said ranges by routine experimentation, in order to optimize the texture of the formulation.

Regarding the dimethicone copolyol (claims 16-20 and 64-68), Hanna et al teach the presence of dimethicone copolyol in the W/O emulsion (col. 5, lines 3-5).

Regarding the amount of dimethicone copolyol (claims 21 and 69), Hanna et al teach that the amount of oil surfactant useful in the W/O emulsion is most preferably 8-

10 wt.% (col. 5, lines 29-33). This is comparable to Applicant's amount of from 5% to 10% by weight.

Regarding the amount of isododecane or volatile hydrocarbon based oil (claims 22-24 and 77-79), Hanna et al teach that the W/O emulsion preferably contains 10-55% oil (col. 2, lines 62-65). These amounts overlap those of the claimed invention, and one skilled in the art would be motivated to select amounts of isododecane from within said ranges by routine experimentation, in order to optimize the stability of the resultant emulsion.

Regarding the additional volatile oil (claims 25-30 and 80-85), Hanna et al teach that the composition may also contain other oils commonly used in cosmetic emulsions such as silicone oils, including volatile silicone oils such as linear and cyclic silicone oils (col. 3, lines 33-35). Bara teaches that silicone oils such as decamethylcyclopentasiloxane are known to be used in W/O emulsions for making up the skin (col. 3, lines 33-42). Thus, it would have been within the purview of the skilled artisan to select silicone oils such as decamethylcyclopentasiloxane as the silicone oils taught by Hanna et al. Additionally, Hanna et al teach that oil is 10-55% of the composition, and the silicone oil is 0-50% of the oil (col. 2, lines 62-63 and col. 3, lines 37-42). Therefore, the amount of additional volatile oil is 0-27.5%. This amount range overlaps those of the claimed invention, and one skilled in the art would have been motivated to manipulate the amount of additional oil present by routine experimentation, in order to optimize the desired feel and behavior of the composition, as taught by Hanna et al (col. 3, lines 37-38).

Regarding the aqueous phase (claims 40-42 and 95-97), Hanna et al teach that solid particles are present in the emulsion (col. 3, lines 45-49), and therefore water-dispersible compounds are present in the aqueous phase. Additionally, Hanna et al teach that the aqueous phase is present in an amount ranging more preferably from 30 to 50% by weight (col. 2, lines 37-38). This amount is comparable to or overlaps that of the claimed invention, and one skilled in the art would be motivated to select amounts of isododecane from within said ranges by routine experimentation, in order to optimize the stability of the resultant emulsion.

Regarding the C_8-C_{22} alkyl dimethicone copolyol (claims 49 and 70-74), Hanna et al teach the presence of cetyl dimethicone copolyol in the W/O emulsion (col. 5, line 5), in an amount of 5-15% (col. 5, lines 29-33). This amount is comparable to Applicant's amounts, and it would be within the purview of the skilled artisan to adjust the amount of surfactant by routine experimentation, in order to optimize the stability of the resultant emulsion.

Regarding the volatile hydrocarbon-based oil (claims 49, 75, and 76), Hanna et al teach that isododecane is present in the W/O emulsion (col. 1, lines 49-55).

Regarding the form of the composition (claim 103), Hanna et al teach that the composition is in the form of a skin makeup composition (for example, see col. 7, Example).

Response to Arguments

6. Applicant's arguments filed 1/29/08 have been fully considered but they are not persuasive.

Applicants first argue that Bara is directed to a very different technical problem than either Hanna or the presently claimed invention, since Bara teaches a matting agent, Hanna teaches cosmetic products that are waterproof and have transfer resistant properties, and the claimed invention is directed to cosmetic compositions having good slip qualities such that the cosmetic can be distributed uniformly. Applicants argue that the problems of matte appearance, water resistance and slip qualities are all independent problems requiring differing solutions, and therefore a person having ordinary skill in the art of cosmetics would have had no reason to combine a reference directed one problem with a reference directed to another.

This argument is not persuasive because both Hanna et al and Bara are both drawn to W/O emulsions used in cosmetic make-up compositions, and one skilled in the art of cosmetic W/O emulsions would be motivated to add polymethyl methacrylate to the emulsion of Hanna et al, since the addition of polymethyl methacrylate to cosmetic W/O emulsions provides the benefit of modifying the texture of the formulation and thus improves its aesthetic feel, as taught by Bara.

Applicants then argue that Bara specifically teaches away from including the presently claimed invention, since Bara states that fillers such as polymethyl methacrylate "have the disadvantage of not imparting a natural appearance to the skin by giving a powdery or even plaster-like appearance and of accentuating skin blemishes".

This argument is not persuasive because Bara specifically teaches that polymethyl methacrylate may be present in cosmetic W/O emulsions in order to modify

the texture of the formulation (col. 3, line 66 – col. 4, line 4). Even if polymethyl methacrylate is not a part of the preferred embodiments of the composition of Bara, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi,* 440 F.2d 442, 169 USPQ 423 (CCPA 1971). See MPEP 2123.

Applicants finally argue that they have demonstrated "highly unexpected results", as submitted in their Declaration under 37 CFR 1.132. Applicants assert that the composition comprising polymethyl methacrylate showed superior slip qualities over the composition comprising nylon powder, as seen in Table 2 of the Declaration. Applicants argue that the teaching of Bara that additional fillers such as polymethyl methacrylate might be incorporated into cosmetic compositions would not have rendered the presently claimed invention obvious, because the use of polymethyl methacrylate results in unexpected advantages that distinguish it from the other fillers listed by Bara.

This argument is not persuasive. The declaration is not persuasive for overcoming the prior art, since applicants have not compared the closest prior art of Hanna et al, which teaches the use of talc as a filler (see Example, col. 7).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BARBARA FRAZIER whose telephone number is (571)270-3496. The examiner can normally be reached on Monday-Thursday 9am-4pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571)272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BSF

/Sharmila Gollamudi Landau/
Supervisory Patent Examiner, Art Unit 1611